

REMARKS

The last Office Action has been carefully considered.

In the Office Action the Examiner rejected claims 37-42, 44-49, 52-62, 66-68 and 70-71 under 35 U.S.C. 103 (a) over the Alanara reference in view of the Vanttila reference.

Claim 48 was rejected as above, and further in view of the Söderbacka reference.

Claim 65 was rejected as above. Claim 69 was rejected over the Alanara reference in view of the Vanttila reference and in view of the Proust reference.

Claims 63 and 64 were rejected in view of the Alanara reference in view of the Vanttila reference and the Hanson reference.

Claim 72 is allowed.

After carefully considering the Examiner's grounds for the rejection of the claims over the art, claims 37 and 71 have been amended to more clearly define the present invention and to distinguish it from the prior art.

It is respectfully submitted that claims 37 and 71 currently on file clearly and patentably distinguish the present invention from the prior art.

In paragraph 3 of the Office Action the Examiner stated that in the present application the notification message differentiates from the short message in that the notification message does not use a short message technology. This statement is however not correct. In accordance with the present invention as defined in claims 37 and 71 as the notification message, a first data field of the short message is transmitted. As explained in lines 27-31 on page 13 of the specification, the first data field can correspond to the data field already prescribed for the SMS by the GSM standard and can be limited in its size to 160 7 bits ASC II text characters. Therefore the notification message can be received as conventional SMS-short message

from a plurality of mobile radio devices, so that the subscriber with the received notification message can determine from the makeup and/or content of the short message, whether the complete short message or parts thereof can be downloaded on its mobile radio device or whether its mobile radio device is in the position to download the complete short message or parts thereof, that are different from the first data field. Claims 37 and 71 have been amended to define that the notification message is not transmitted together with the short message. This is specifically disclosed in lines 29-31 on page 10 and lines 1-8 of the specification.

In paragraph 10 of the Office Action the Examiner indicated that in the Alanara reference the notification message and the short message are transmitted in the same message. To the contrary in the Vanttila reference, in particular, column 5, lines 13-24 the feature is provided, in accordance with which a notification message is different than the short message. As explained in the previous Amendment the Vanttila reference does not disclose the features of claims 37 and 71, in accordance with which as the notification message first data field of the short message is transmitted. In paragraph 9 of the Office Action the Examiner indicated that

the Vanttila notification message does not have a first data field of the short message transmitted, and claims 37 and 71 do not require transmitting a data field of the short message, only data about the content or makeup of short message. The statement is not understood since claims 37 and 71 clearly define the step of “transmitting to the subscriber as a notification message, a first data field of the short message.” The Examiner’s opinion is therefore not correct.

In paragraph 8 of the Office Action, the Examiner made a conclusion that the Vanttila reference discloses a message notifying the user if he/she wants the service in a notification message. Such a message is considered as a “notification message”. The Examiner is however not correct in his conclusion. The reason is that the notification message of claims 47 and 31 includes data which contain information about the makeup and/or the content of the short message. The consideration of the subscriber in the Vanttila reference is however carried out whether it will perceive an offered service or not. The offered service in the Vanttila reference is however differentiates from a short message defined in claims 37 and 71. In other words a notification about a service offered from the network in

accordance with the Vanttila reference is different from a notification message about the makeup and/or the content of a short message as defined in claims 37 and 71.

Neither the Alanara reference nor the Vanttila reference disclose the feature defined in claim 37 and 71, in accordance with which a notification is transmitted not together with the short message and it is formed as a data field of the short message. This feature means, in other words, that while the notification message is formed as a data field of the short message, and it nevertheless is not transmitted together with the short message. This feature is not disclosed in the references and can not be derived from them as a matter of obviousness.

It is therefore believed to be clear that the new features of the present invention as defined in claims 37 and 71 are not disclosed in the references applied by the Examiner, namely in the Alanara reference and Vanttila reference, as well as in other references applied against some dependent claims.

Any combination of the references would not lead to the applicant's invention as now defined in these claims.

In order to arrive at the applicant's invention from the combination of the references in the sense of 35 U.S.C. 103 the references have to be fundamentally modified by including into them the new features of the present invention as now defined in the above mentioned claims in which the language were first proposed by the applicant. However, it is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such modification.

This principle has also been consistently upheld by the U.S. Court of Customs and Patent Appeals, which for example, held in its decision in re Randol and Redford (165 USPQ 586) that

Prior patents are references only for what they clearly disclose or suggest, it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

Reconsideration and allowance of the present application is

most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance; he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,

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